

REMARKS

In response to the Official Action mailed April 27, 2004, Applicants amend their application and request reconsideration. In this Amendment, no claims are added or canceled so that claims 1-62 remain pending. No new matter has been added.

The Official Action objects to the title as not descriptive. A new title is provided.

The Official Action rejects claims 1, 3-7, 17-19, 29-30, 33, 35-38, and 53-55 as unpatentable over Kikinis (US Patent 5,708,776) in view of Ice, Jr. et al. (US Patent 6,658,563, hereinafter Ice). That rejection is respectfully traversed.

Ice is not prior art to the present application. This application claims priority from application no. 60/168,048 filed on November 30, 1999 (see page 1, first paragraph, of the patent application). However, Ice was filed May 18, 2000, which is after November 30, 1999, the priority filing date of the present application. Thus, Ice cannot be a prior art reference under any section of 35 U.S.C. § 102. Accordingly, Ice cannot be used to support a rejection under 35 U.S.C. § 103. Therefore the rejection is erroneous and should be withdrawn.

Furthermore, Kikinis fails to teach or suggest determining whether or not the computer system can complete the boot process using the system image on the first partition. Kikinis merely discloses that the computer is booted off of the second partition if the number of re-boots in a predetermined time period exceeds a threshold value (column 3, lines 8-32 of Kikinis). Thus, if the computer is re-booted a number of times exceeding the threshold value, the computer will boot off of the second partition even though it may be that the computer can complete the boot process using the first partition. Kikinis does not disclose that the computer boots using the second partition because the booting off the first partition *did not complete*. Thus, Kikinis fails to teach or suggest this limitation of claim 1, and similar limitations in claims 17, 29, 33, and 53. Accordingly, the rejection of these claims, as well as their depending claims, is erroneous and should be withdrawn.

Still further, regarding claim 53, Kikinis fails to teach or suggest a file on the first storage device indicative of the status of a previous boot process performed by the computer system. The Official Action does not explicitly allege how Kikinis teaches such a file. Applicants have reviewed Kikinis and find no such teaching. Accordingly, the rejection is erroneous and should be withdrawn.

The Official Action rejects claims 2, 20-22, 31-32, and 56-58 as unpatentable over Kikinis in view of Ice and further in view of Meyer et al. (US Patent 6,170,055, hereinafter Meyer). That rejection is respectfully traversed.

As previously discussed, Ice cannot be a prior art reference under any section of 35 U.S.C. § 102. Accordingly, Ice cannot be used to support a rejection under 35 U.S.C. § 103. Therefore the rejection is erroneous and should be withdrawn.

The Official Action rejects claims 8-13 and 39-42 as unpatentable over Kikinis in view of Ice and in further view of Bealkowski et al. (US Patent 5,410,699, hereinafter Bealkowski). That rejection is respectfully traversed.

As previously discussed, Ice cannot be a prior art reference under any section of 35 U.S.C. § 102. Accordingly, Ice cannot be used to support a rejection under 35 U.S.C. § 103. Therefore the rejection is erroneous and should be withdrawn.

Furthermore, regarding claims 9, 12, 40, and 42, the Official Action contends that Kikinis inherently teaches obtaining the result of a previous attempt to complete the boot process using system image on the first partition. However, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Official Action has not demonstrated how the allegedly inherent limitation necessarily flows from the teachings of Kikinis. Applicants respectfully submit that the limitation is, in fact, not inherent to Kikinis. As previously discussed, Kikinis bases whether or not to boot using another partition on the number of times a re-boot has occurred, not the result of a prior boot. Accordingly, the rejection is erroneous and should be withdrawn.

The Official Action rejects claims 23-27 and 45-51 as unpatentable over Kikinis in view of Ice and Meyer, and further in view of Bealkowski. That rejection is respectfully traversed.

As previously discussed, Ice cannot be a prior art reference under any section of 35 U.S.C. § 102. Accordingly, Ice cannot be used to support a rejection under 35 U.S.C. § 103. Therefore the rejection is erroneous and should be withdrawn.

Furthermore, regarding claims 23 and 45, Kikinis fails to teach or suggest determining whether or not the computer system can complete the boot process using the system image on the first partition, as previously discussed with regard to claim 1. Accordingly, the rejection of claims 23 and 45, and their respective depending claims, is erroneous and should be withdrawn.

The Official Action rejects claims 59-62 as unpatentable over Kikinis in view of Ice and further in view of Miller (US Patent 6,308,265). That rejection is respectfully traversed.

As previously discussed, Ice cannot be a prior art reference under any section of 35 U.S.C. § 102. Accordingly, Ice cannot be used to support a rejection under 35 U.S.C. § 103. Therefore the rejection is erroneous and should be withdrawn.

Furthermore, Kikinis fails to teach or suggest determining whether or not the computer system can complete the boot process using the system image on the first partition, as previously discussed with regard to claim 1. Accordingly, the rejection of claim 59, and its depending claims, is erroneous and should be withdrawn.

Claims 14-16, 28, and 43-44 are objected to for being dependent on a rejected base claim, but would be allowable if rewritten in independent form. Accordingly, no remarks are made regarding these claims.

Because no claims are amended in this Amendment, another rejection based on new grounds should not be made final.

In re Appln. of RAGHAVAN et al.
Application No. 09/713,108

Reconsideration and withdrawal of the rejections, as well as prompt allowance of the pending claims, are appropriate and earnestly solicited.

Respectfully submitted,



A. Wesley Ferrebee, Reg. No. 51,312
LEYDIG, VOIT & MAYER
700 Thirteenth Street, N.W., Suite 300
Washington, DC 20005-3960
(202) 737-6770 (telephone)
(202) 737-6776 (facsimile)

Date:

7/21/04

Amendment or ROA - Regular (Revised 6/5/04)